

REMARKS

This responds to the Office Action mailed on August 12, 2009.

Claim 19 is amended, no claims are canceled or added; as a result, claims 1-37 remain pending in this application. Support for the amendments to claim 19 may be found throughout the specification, and at least at page 4, lines 10-22 of the specification. Applicant respectfully submits that no new matter has been introduced with the amendment.

§ 101 Rejection of the Claims

Claims 1-37 were rejected under 35 USC § 101 as being directed to non-statutory subject matter because the claims were asserted to be method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor tied to another statutory class (such as a particular machine). Applicant respectfully traverses the rejection.

Applicant refers the Examiner to the “INTERIM EXAMINATION INSTRUCTIONS FOR EVALUATING SUBJECT MATTER ELIGIBILITY UNDER 35 U.S.C. § 101” provided on August 24, 2009 (hereinafter “the Guidelines”). While the guidelines do not have the force of law, they are believed to be useful in the present matter. With respect to the particular machine portion of the Bilski machine or transformation test, the Guidelines state:

For computer implemented processes, the “machine” is often disclosed as a general purpose computer. In these cases, the general purpose computer may be sufficiently “particular” when programmed to perform the process steps. Such programming creates a new machine because a general purpose computer, in effect, becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software. To qualify as a particular machine under the test, the claim must clearly convey that the computer is programmed to perform the steps of the method because such programming, in effect, creates a special purpose computer limited to the use of the particularly claimed combination of elements (i.e., the programmed instructions) performing the particularly claimed combination of functions. (see Guidelines, page 6)

Claims 1-18 and 37 recite a “computerized gaming system” and positively recite a gaming module that includes a process to execute the gaming module. The computerized gaming system clearly is a particular machine, as it is even more particular than the general purpose computer

that is sufficiently particular when programmed to perform actions that is statutory subject matter under the Guidelines. Thus claims 1-18 recite a particular machine. Similarly, claims 19-36 recite a method of providing audio on a computerized gaming system, and further positively recite that “the computerized gaming system further operable to conduct a wagering game upon which monetary value can be wagered.” Thus claims 19-36 are tied to a particular machine.

For the reasons above, claims 1-37 satisfy the “particular machine” prong of the Bilski test under the Office’s current interpretation of 35 U.S.C. § 101. Therefore claims 1-37 recite statutory subject matter. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1-37.

§ 102 Rejection of the Claims

Claims 1-37 are rejected under 35 U.S.C. 102(a) as being anticipated by Hecht et al (US 2003/0073489 A1). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P. § 2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. v. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that the claims recite elements not found in Hecht, and are therefore not anticipated by Hecht.

For example claim 1 recites an audio module that is operable to select audio element tracks that are played at the same time, wherein the “selected audio element tracks comprise two or more instruments played in the same key in synchronization.” Claim 37 recites similar language. The Office Action states that Hecht, at paragraphs [0009], [0043] and [0050] discloses

the recited subject matter. Applicant respectfully disagrees with this interpretation of Hecht. Paragraphs [0009] and [0043] do not make any reference to keys or selecting track elements having the same key. Paragraph [0050] references keys, but rather than selecting track elements having the same key, Hecht discloses the opposite, that a track having a different key is selected or created. In particular, paragraph [0050] states that "if a player makes input W, the gaming device plays the same song in key D and then stops playing the song in key C." This is consistent with paragraphs [0015] and [0060] of Hecht which also state that a key is changed. At no point in the specification does Hecht disclose selection of audio tracks having the same key for simultaneous playback. Therefore Hecht fails to disclose each and every element of claims 1 and 37.

Applicant thanks the Examiner for the clarification of the Examiner's position provided in the "Response to Arguments" portion of the Office Action. Applicant respectfully disagrees that paragraph [0052] discloses the simultaneous play of two track in view of the language at the beginning of paragraph [0052] that specifically states that the "CPU makes a change from playing an initial sound recording to a variant of that sound recording." It is Applicant's view that the simultaneous actions referred to are detecting sound causing events and playing a new sound recording that is on-beat with the beat of the initial recording such that the new sound recording has the same beat as the initial recording.

For the reason above, Applicant respectfully submits that claims 1 and 37 recite elements not found in Hecht. Therefore Hecht does not anticipate claims 1 or 37. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1 and 37.

Claims 2-18 depend from claim 1 and thus inherit the elements of claim 1. Therefore claims 2-18 are not anticipated by Hecht for at least the same reasons as discussed above regarding claim 1.

Claim 19 has been amended to more particularly recite the selection of multiple tracks having from a group of audio track elements having a desired key. As discussed above with respect to claims 1 and 37, Hecht does not disclose such elements. Therefore Hecht does not anticipate claim 19. Claims 20-36 depend from claim 19, and are therefore not anticipated by Hecht for at least the same reasons as discussed above regarding claim 19.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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By 1/12/2010

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of August, 2009.

Zhakalazky M. Carrion

Name

1/12/2010
Signature